



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/709,978

06/10/2004

Lydia Breck

03292.101070.3

3977

66569 7590 02/20/2007
FITZPATRICK CELLA (AMEX)
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

NEWTON, JARED W

ART UNIT

PAPER NUMBER

3692

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
--	-----------	---------------

3 MONTHS

02/20/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/709,978	BRECK ET AL.	
	Examiner	Art Unit	
	Jared W. Newton	3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/10/2004; 8/10/2004; jwn</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

This application is a division of Application No. 09/800,461 filed March 7, 2001, which claims priority from Provisional Application No. 60/187,620 filed March 7, 2000.

Information Disclosure Statement

The information disclosure statement filed August 1, 2004 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,826,241 to Stein et al. (Stein).

In regard to claim 1, Stein discloses a method and payment system for facilitating secure financial transactions between two users (i.e. a merchant and customer) over the internet; the transaction of funds occurs via messages sent between the users (see

Art Unit: 3692

FIGS. 5 and 6A-Q). The system employs a front end program 90 and a back end program 92, wherein the front end program provides only limited information regarding a user's account (credit or other), providing a user with heightened security by isolating the account identifying information (see FIG. 3; see Abstract). Within said method and system, Stein discloses a method for dispute handling comprising the steps of: receiving a dispute from a first party (see col. 11, line 54 – col. 12, line 7) relating to a transaction involving a secondary transaction number 142 or 144 (see col. 7, lines 58-67) associated with at least one primary account ("cardholder account"); retrieving transaction information from a stored data file 114 (see FIG. 3; see also col. 5, lines 65-67); replacing the primary account number with the secondary transaction number to initiate a second party inquiry (see col. 12, lines 1-7); wherein the second party inquiry references only the secondary transaction number (see id.).

In regard to claim 2, Stein further discloses the steps of: determining if a valid approval code is associated with the secondary transaction number in payout-chargeback-notification message sent to seller (see col. 12, lines 1-7); and charging back to the second party the amount of the transaction, if a valid approval code does not exist. Stein discloses the buyer's (first party's) indication 152 of willingness to allow transfer of funds via message 150 (see FIG. 6F). Said willingness corresponds to identifiers 142 and 144, and acts as a transaction approval code or signal. It follows that if willingness indicator 152 is "no" or "fraud" (i.e. if the valid approval indicator "yes" does not exist) (see col. 8, lines 11-18), and the transaction occurs, then the dispute will be

Art Unit: 3692

resolved in favor of the buyer, and the chargeback will occur (see col. 11, line 54 – col. 12, line 7).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

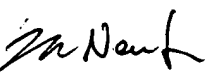
- US Patent App. Pub. No. 2004/0006539 to Royer et al.
- US Patent App. Pub. No. 2004/0083184 to Tsuei et al.
- US Patent App. Pub. No. 2003/0018567 to Flitcroft et al.
- US Patent No. 7,136,835 to Flitcroft et al.
- US Patent No. 7,100,821 to Rasti
- US Patent No. 6,636,833 to Flitcroft et al.
- US Patent No. 6,336,095 to Rosen
- US Patent No. 6,330,544 to Walker et al.
- US Patent No. 5,453,601 to Rosen
- UK Patent App. No. GB 2361790 to Arndt
- Lamond, "Credit Card Transactions Real World and Online" © 1996
- Gabber et al., "Agora: A Minimal Distributed Protocol for Electronic Commerce," USENIX November 18, 1996.

Art Unit: 3692

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jared W. Newton whose telephone number is (571) 272-2952. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (571) 272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Jared W. Newton
February 13, 2007
JWN


RICHARD E. CHILCOT, JR.
SUPERVISOR OF PATENT EXAMINER